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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/018,002

04/12/2002

John Quentin Phillips

8004-14 (07 39981)

7101

7590

05/14/2007

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EXAMINER

NEWTON, JARED W

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

05/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/018,002

Applicant(s)

PHILLIPS, JOHN QUENTIN

Examiner

Jared W. Newton

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

The claims are objected to because of the following informalities:

- The word "include" should be replaced with --includes-- (Claim, line 11).
- The word "substitute" should be changed to --substitutes-- (Claim 1, line 11).
- The word "signalling" (used twice) should be changed to --signaling-- (Claim 8, line 8).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 8 recites:

"search means for searching the database for the destination IP address in a message from the user terminal; identification means responsive to the search means finding an IP address in the database to identify said action definition in the message; and signalling [sic] means for signalling [sic] action definition parameters to the financial service provider site in dependence on identification of an action definition by the identification means and receiving a transaction ID or other data not comprising a payment card number therefrom; means for substituting at least a payment card number within the parameter or parameters of said action definition with the transaction ID or other data; and transmission means for sending the modified message to the vendor site."

The specification and drawings do not provide sufficient support so that one of ordinary skill in the art could make or use the "search means," "identification means," "signalling [sic] means," and "means for substitution."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 5, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,815,665 to Teper et al. (hereafter Teper).

In regard to claim 1, Teper discloses a system and method for conducting transactions over the Internet, said system comprising:

- an internet connectivity provider site (see col. 7, lines 40-44);

- a financial service provider site 60 (see FIG. 1) for producing transaction identifications ("session ID" – see col. 11, lines 27-28);

- a user terminal 40 (see FIG. 1) programmed with a web browser program and connectable to the Internet connectivity provider site for accessing the Internet; and

- a world wide web vendor site 50 (see FIG. 1) configured for sending a payment card information entry form 88' (see FIG. 3) having an action definition, having at least one parameter, associated therewith, wherein the Internet connectivity provider site is configured to intercept messages from the user terminal, which includes said action definition and substitutes at least a payment card number within the parameter or parameters of said action definition with a transaction ID produced by the financial service provider site. Teper recites: "[U]sers provide various account information to the Online Broker, such as payment information (e.g., credit card number), name, address and phone number. This information is maintained in a brokering database at the Online Broker site, and is not exposed to the Service Providers . . . In operation, when a user connects to a registered SP site and attempts to access an online service, the SP site initiates a challenge-response authentication sequence which allows the Online Brokering Service to authenticate the user for the SP site. In the preferred

embodiment, the SP site sends a challenge message to the user's computer over the distributed network (e.g., the Internet), and the user computer responds by generating and returning a cryptographic response message . . . Upon determining that a user is authentic, the Online Brokering Service preferably sends an anonymous session ID to the SP site to allow the SP site to anonymously bill the user for services subsequently purchased. As the user purchases online services (such as software downloads, accesses to online publications, etc.), the SP site sends billing events to the Online Brokering Service, with each billing event specifying both the anonymous session ID and a charge to be applied to the user's account." (See col. 2, line 57 – col. 3, line 45).

In regard to claim 2, Teper further discloses said system employing hypertext transfer protocol (HTTP) (see col. 11, lines 34-45). It is inherent within HTTP that all messages transferred between the user computer 40, service provider site 50, and online broker site 60 would be published in HTML form. It is further inherent that said messages would each include a unique Uniform Resource Locator (URL) to identify messages sent between the user, service provider, and broker, wherein said URLs would be published in HTML, corresponding to the HTTP. (See also col. 9, lines 38-49).

In regard to claim 5, Teper further discloses said vendor (SP) sites as capable of recognizing an un-substituted parameter (i.e. credit card number), and recording a transaction in a first manner (see col. 1, lines 54-65 – Teper discloses the prior art method of a user transmitting payment (i.e. credit card) information directly to a service provider site). Teper further discloses said sites as configured to recognize substituted

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parameters (i.e. session IDs) that identify a transaction in a second manner (see col. 11, lines 27-28).

In regard to claim 8, Teper further discloses at least one database 64 of vendor sites (see col. 8, lines 54-62), some means for searching and identifying said vendor sites within said database (see col. 9, lines 38-49), some means for signaling a vendor site, and providing in dependence thereon a substituted parameter transaction ID in a message to the vendor site (see col. 9, lines 50-60).

In regard to claim 9, Teper further discloses said transmission means as configured to mimic the user terminal when sending said modified message (see id.).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper, as applied to claim 1 above, alone.

In regard to claims 3 and 4, Teper discloses the system and method as set forth above, and further discloses said user terminal 40 including an input means and a modem means (see col. 8, lines 1-6). Teper does not explicitly disclose modem control data that is not modifiable by means of data input using the user input means alone (claim 3) and read-only storage means storing a machine specific ID (claim 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a computer having modem control data that is not modifiable by means of data input using the user input means alone, and read-only storage means storing a machine specific ID, to implement the three party Internet-based transaction system as disclosed by Teper. The modem control data and storage means were well known at the time of the invention as options for a personal computer user's system, and would be obvious and successful for implementing the internet-based system of Teper.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper, as applied to claims 1 and 5 above, and further in view of US Patent No. 5,692,132 to Hogan (hereafter Hogan).

In regard to claims 6 and 7, Teper discloses the system and method as set forth above, including substituting parameters (i.e. account numbers) with transaction IDs to complete a transaction, but does not explicitly disclose said system as capable of recognizing an indication of a reason for non-completion of the transaction and sending a page to the user terminal in dependence thereon (claim 6), wherein said reason is insufficient credit or incorrectly entered payment card related data (claim 7). Hogan discloses a system and method for conducting transactions over a computer network, wherein a user computer 100 purchases goods from a merchant site hosted on a merchant computer 300, through a financial services provider (FSP) site that maintains a user's account information (see FIG. 1). Hogan further discloses said system as



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configured to send a page to a user terminal indicating a reason for non-completion of a transaction, wherein said reason is insufficient funds. Hogan recites:

“If computer 100 detects, in step 511, that the user chose the purchase option, computer 100, in step 552, analyzes whether the purchase price subtracted from the balance stored in memory 101 results in a negative number. If, in step 552, the resulting balance is a negative number (indicating that the price of the item is greater than the account balance stored in computer 100), a message is displayed, in step 570, informing the user that his account balance is insufficient to purchase the product and that he must request a reload to continue.” (See col. 9, lines 26-39) (See also FIG. 5B).

The Teper and Hogan references are analogous art because they are in the same field of endeavor—internet-based transactions involving third party services for facilitating the transaction. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the means for indicating the insufficiency of an account, as disclosed by Hogan, to the system disclosed by Teper. Teper discloses a novel system for conducting anonymous transactions over the Internet, but does not explicitly address the situation where a user lacks funds to purchase a quantity of goods. Hogan provides an obvious and successful solution to this problem by sending a message to a user when his funds are insufficient. The motivation for providing the indication means would be that as set forth by Hogan—to allow a user of the Teper system to stay apprised of his account balance, and chose to reload the account if it reaches a low amount.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

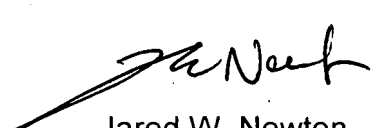
- US Patent No. 6,944,669 to Saccocio
- US Patent No. 6,938,022 to Singhal
- US Patent No. 6,725,222 to Musgrove et al.
- US Patent No. 6,714,933 to Musgrove et al.
- US Patent No. 6,697,865 to Howard et al.
- US Patent No. 5,884,272 to Walker et al.
- Cox et al., "NetBill Security and Transaction Protocol," USENIX Workshop on Electronic Commerce, New York, NY, 1995.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jared W. Newton  
May 4, 2007  
JWN



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